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No. 84-

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1984

MARK LANDSBERG,
Petitioner,

VS.

SCRABBLE CROSSWORD GAME PLAYERS, INC.;
SELCHOW & RIGHTER, Co.; and
CROWN PUBLISHERS,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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QUESTIONS PRESENTED

1. Does the policy of promoting the free use of ideas require a different application of the copyright laws to works of non-fiction than to works of fiction?

2. Does the free use of ideas policy prevail over the policy of Art. I, Sec. 8, to "promote the Progress of Science and Useful Arts" so as to require that the scope of copyright protection for works of non-fiction be narrowed?

THE PARTIES

The parties before this Court are those set forth in the caption.

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Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Petitioner Mark Landsberg respectfully prays that a writ of certiorari issue to review the order and opinion of the United States Court of Appeals for the Ninth Circuit entered in this proceeding on March 5, 1984 and amended on May 8, 1984.

OPINION BELOW

The opinion of the Court of Appeals is reported at 736 F.2d 485 (9th Cir. 1984) and is annexed hereto as Appendix A. The District Court opinion is reported at 212 USPQ 155 (C.D. Cal. 1979) and is annexed hereto as Appendix B. The

District Court's Findings of Fact and Conclusions of Law are reported at 212 USPQ 159 (C.D. Cal. 1980) and are annexed hereto as Appendix C.

JURISDICTION

The opinion and order of the Court of Appeals was entered on March 1, 1984. A timely petition for rehearing and rehearing *en banc* was denied on July 3, 1984, and this petition of certiorari is filed within 90 days of that date. The order denying rehearing is annexed hereto as Appendix D. This Court's jurisdiction is invoked under 28 U.S.C. § 2101 (1976).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I Sec. 8 of the Constitution provides:

> The Congress shall have Power . . . to promote Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

STATEMENT OF THE CASE

Petitioner Landsberg is the author of, and owner of the copyrights to, the work entitled "Championship Scrabble Strategy". In 1972, Landsberg furnished Respondent Scrabble Crossword Game Players, Inc. (a wholly owned subsidiary of Respondent Selchow & Righter Co.) with a copy of his manuscript embodying his copyrighted work. Soon after negotiations broke down between Landsberg and Respondents for the rights to Landsberg's work, Respondents published their own book entitled "The Official Scrabble Players Handbook" which was remarkably similar to Landsberg's manuscript. Petitioner's 1976 suit brought in state

court was removed to the United States District Court for the Central District of California. Petitioner's action was based *inter alia* on common law copyright infringement (then permitted under former Cal.Civ. Code § 980).

After a bench trial, the District Court found that Respondents had paraphrased Mr. Landsberg's copyrightable expression and that their resultant book was substantially similar in expression to Landsberg's work and that the differences that did exist were merely crude attempts to cover up copying.

The Court of Appeals for the Ninth Circuit reversed, holding that "similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed." (A7). Based on its review of the two works involved the Court of Appeals concluded that there was not the requisite verbatim reproduction or very close paraphrasing necessary for infringement of a "factual" work. (A8).

STATEMENT OF FACTS

A succinct statement of the facts of this case can be found in the trial judge's (The Honorable Laughlin E. Waters) Findings of Fact 3-7 and 11-44 (A 26-32) which are set out verbatim herein below for the convenience of the Court:[1]

3. Plaintiff [Petitioner, Mark Landsberg] is the author of an original, unpublished literary work entitled "CHAMPIONSHIP SCRABBLE STRATEGY" [hereafter the accusing work] (Exh 1).

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[1]The "FACTS" as set out in the opinion of the Court of Appeals (A1-4) are consistent with those recited here.

4. Plaintiff, at all material times, was and is the sole owner of the common law copyright in the accusing work.

5. Defendants Crown and S&R [which include Scrabble Crossword Game Players, Inc.] were, at the commencement and removal of and throughout this action, corporations incorporated in, and having their principal places of business in, states other than California.

6. Defendant S&R is the owner of the trademark "SCRABBLE" under which brand it markets several versions of its best-selling "Crossword Game", commonly known as the game of Scrabble.

7. Within two years of the commencement of this action in the Superior Court of the State of California, S&R published, for the first time, a literary work originally entitled SCRABBLE PLAYERS HANDBOOK (Exh. 2), which ultimately came to be known as the OFFICIAL SCRABBLE PLAYERS HANDBOOK [hereafter the accused work] (Exh. 3). Prior thereto, no published work embodied protected portions of the accusing work.

11. Robert Rosegarten was an account executive at the advertising agency of S&R. Rosegarten acted at all material times as agent for S&R.

12. Michael Senkiewicz was an expert Scrabble player employed by S&R for the purpose of analyzing the accusing work and thereafter for preparing the accused work. Senkiewicz acted at all material times as agent for S&R.

13. Drue Conklin was an account executive at the advertising agency of S&R and was hired and acted at all material times as agent for S&R in connection with producing the accused work.

14. Lee Tiffany was a managerial level employee of S&R generally in charge and responsible for producing and publishing the accused work. Tiffany acted at all material times as agent for S&R within the course and scope of his employment.

15. Plaintiff [Petitioner], in 1972, intended to publish the accusing work.

16. Plaintiff sent a copy of the accusing work to S&R for the purpose of securing permission to use the name "Scrabble" in connection with his proposed publication.

17. S&R, at the time it received the copy of the accusing work from Plaintiff, had been considering for some time the preparation of an updated replacement for an earlier volume on "Scrabble" and had undertaken some efforts in that direction including the collecting of materials and the hiring of an embryonic author. Nothing of substance, however, had been developed by October, 1972. The arrival of the accusing work in November of 1972, therefore, was both fortuitous and timely.

18. Shortly after receiving the accusing work, Tiffany provided a copy to Senkiewicz and requested him to report his opinion of it to S&R.

19. Senkiewicz studied and analyzed the accusing work in detail and reported to S&R that the accusing work was "excellent and, on the whole meritorious" (Exh. 18).

20. The denial by Tiffany of his interest in, appreciation for, and desire to publish the accusing work is not believed by the court and is found to be untrue.

21. (a) After receipt of the accusing work, S&R, through Tiffany and Rosegarten, conducted "negotiations" with Plaintiff for rights in the accusing work.

(b) Although appearing to negotiate, S&R never made an offer of terms on which an agreement could be based but continually led Plaintiff to believe that such terms would be forthcoming.

22. Based on S&R's conduct, Plaintiff reasonably believed that S&R would not use or copy his manuscript, or any portion thereof, without his consent and without payment to him of an acceptable sum. Defendants at no time have obtained Plaintiff's consent to their use or copying of the accusing work and at no time have paid or tendered any payment to Plaintiff.

23. After many months of "negotiations", Plaintiff demanded the return or destruction of all copies of the accusing work in S&R's possession.

24. After receipt of Plaintiff's demand for said return or destruction, no one at S&R requested that Senkiewicz return the copy of the accusing work previously supplied to him by Tiffany.

25. S&R at all times had access to the accusing work and surreptitiously retained one or more copies thereof, notwithstanding Plaintiff's demand for their return or destruction.

26. After Plaintiff terminated "negotiations" with S&R, S&R employed Senkiewicz to produce the accused work and Conklin to be the editor.

27. The ideas expressed in the two works are substantially similar, as is to be expected in a non-fictional work dealing with a narrow subject where the range of choice for inclusion and exclusion is not large.

28. Senkiewicz had no prior history of original authorship or demonstrated writing skills.

29. At all times while engaged in the production of the accused work, Senkiewicz maintained in his apartment, where he allegedly authored the accused work, a copy of the accusing work.

30. Senkiewicz engaged in free, unfettered and indiscriminate copying from other copyrighted works in preparing the accused work.

31. Senkiewicz produced an outline for the accused work shortly after studying in detail the accusing work (E.g., Exh. 53).

32. Senkiewicz's outline was copied from the accusing work.

33. The denial by Senkiewicz that he used and copied from the accusing work s not believed by the court and is found to be untrue.

34. The denial by Conklin that she read the accusing work before publication of the accused work is not believed by the court and is found to be untrue.

35. No source of information on how to play the game of Scrabble, other than the accusing work, was used by S&R in producing the accused work. Mr. Senkiewicz was identified as an expert in the game of Scrabble.

36. Exhibit AK contains a detailed synopsis of the accusing work.

37. Exhibit AK was used by S&R in producing the accused work.

38. The accusing work contains an original and novel idea [hereafter Plaintiff's notational system] for expressing a past-played game of Scrabble.

39. The idea of Plaintiff's notational system is not within the scope of copyright protection.

40. S&R copied and modified Plaintiff's notational system and this conduct is evidence of their propensity to copy from the accusing work and hence is evidence of copying the protected expression in the accusing work, as well as evidence bearing upon the credibility of denials of copying.

41. S&R copied both ideas and the form of expression from the accusing work.

42. The accused work contains no verbatim portions of the accusing work, but does constitute in significant part a paraphrase of it and contains the same substance, and was used as a model by S&R and was copied by them. Defendants paraphrase of both language and theme of the accusing work is a crude effort to give the appearance of dissimilarity.

43. The portions of the accused work summarized in Exhibit 45:

(a) are substantially similar in their expression to, and

(b) were copied from the corresponding portions of the accusing work therein summarized.

44. The accused work is substantially similar to the accusing work.

REASONS FOR GRANTING CERTIORARI

The Ninth Circuit opinion raises important issues concerning the copyright protection afforded works of non-fiction. Although the issue of copyrightability of works of non-fiction is technically before the Court in *Harper & Row v. The Nation,* F.2d 195 (2nd Cir. 1983) (cert granted 1983) No. 83-1632, the restrictions of the First Amendment in the context of "political speech" and the doctrine of fair use in the context of historical facts are so intertwined in that case with the issue of copyright protection that the Court is likely not to reach the core issue.

This case, on the other hand, presents the issue of copyright protection for works of non-fiction (in this case, an author's expression of his opinion on how a game should be played) free from issues of fair use and the First Amendment so as to permit the Court to settle the conflict that exists between the rule of law as announced by the Ninth Circuit in this case and that followed by the courts of other circuits.

By fashioning a rule of law for works of non-fiction requiring verbatim, or near verbatim copying of expression, the Appeals Court so narrowed the protection afforded this important class of works[2] as to virtually exclude them from the copyright laws. The Court of Appeal's decision did not strike the proper balance between promoting the free use of ideas and the encouragement of authorship. In

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[2]Which include the vast array of "how-to" works (useful arts), as well as editorials, criticisms, and scientific writings to name just a few.

the name of free use of ideas, the Appeals Court severely weakened the protection available to authors and publishers of non-fiction works by eliminating the incentives of Art. I, Sec. 8, "to promote the progress of science and useful arts".

The Court of Appeals, in Conflict With Holdings of Other Circuits, Redefined and Severely Limited the Scope of What is Protectable Under the Copyright Laws in a Work of Non-Fiction. These Holdings are Not Required to Advance the Policy of Promoting the Free Use of Ideas

In its holding, the Court of Appeals departs from and is in conflict with the rule in other circuits.

(a) The Rule Prior to this Case

The rule announced by the Court of Appeals is of major importance in that for the first time it announces and applies a different test of infringement for works of non-fiction. Prior to this case, the accepted test for infringement of all works—fiction or non-fiction—has been a test for "substantial similarity" of expression (of the ideas contained within the subject works). 3 Nimmer on Copyright § 13.03(A), pp. 13-18, 13-21 (1984 ed). The axiom of copyright law that copyright protects an author's expression of an idea and not the idea itself, *Mazer v. Stein*, 347 U.S. 201, 217 74 S.Ct. 460 (1954) has given rise to a two step analysis for infringement—(1) identify the ideas of a work and separate them from their expression, and (2) determine whether or not there is substantial similarity of expression. This test has been applied equally to works of non-fiction as well as fiction.

Every copyrighted work necessarily has a different blend of idea and expression varying from the work in which the idea so dominates that there is no independent expression (Cf. *Herbert Rosenthal Jewelry Corp.* v. *Kalpakian,* 446 F.2d 738 9th Cir. 1971)) to the work of fantasy where the idea provides only the most general theme and all the rest is expression (Cf., *Universal Film Studios v. Film Ventures International,* 543 F.Supp. 1134 (C.D. Cal. 1982)). Since it does not always follow that non-fictional works will have only a minor component of expression and all fictional works will be primarily expression, a separate test for infringement of works of non-fiction has not heretofore evolved.

(b) The "Verbatim Rule" of This Case

The Court of Appeals, after holding that in the eyes of copyright law "[f]actual works are different" (A6) announces the rule of law that "similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed." (A7).

By holding that in the case of non-fictional works the similarity of *expression* necessary to constitute infringement must be greater than substantial (verbatim or near verbatim), the Court of Appeals fashions a new rule of law.

The application of the copyright laws is thus materially altered. Rather than compare the expression components of two works to see if there is substantial similarity, infringement analysis now requires only that a work be categorized as "factual"[3] and then tested for verbatim or near

[3]What is "factual" and what is "not factual" is such a difficult determination that one has to assume that the Court used the word "factual" (A6) to mean non-fictional. In the present case, for ex-

verbatim copying. Since non-fictional works often have significant expression components, the application of the Verbatim Rule permits copying of that expression so long as the copying is not essentially verbatim. This result is, of course, contrary to the purpose of the copyright laws and does not serve to promote the constitutional desiderata.

(c) The Appellate Court's Holdings are Contrary to Those of Other Circuits

The abandonment of the traditional idea/expression analysis in favor of a Verbatim Rule for non-fictional works conflicts with the holdings of other circuits.

In *Orgel v. Clark Boardman Company*, 301 F.2d 119 (2nd Cir. 1962), the Court dealt with the alleged infringement of a book on condemnation which dealt with valuation. The Court recognized "that any two books treating the same subject matter, particularly in the field of law where words and phrases are often terms of art, and based upon common sources are bound to contain a large measure of innocent similarity" found infringement without finding verbatim copying or close paraphrasing. In an earlier Second Circuit case, *Nutt v. National Institute Incorporated for the Improvement of Memory*, 31 F.2d 236 (2nd Cir. 1929), the Court found infringement of plaintiff's copyrighted lectures on memory improvement and in doing so stated that "the infringement need not be a complete or exact copy. Paraphrasing or copying with evasion is an infringement, even though there may be little or no conceivable identity between the two". *Nutt, supra* at 237.

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ample, it is highly doubtful that Mr. Landsberg's opinions on how the game of Scrabble should be played is a "factual work" although it is clearly non-fictional.

In *Meredith Corp. v. Harper & Row Publishers, Inc.*, 378 F.Supp. 686 (S.D.N.Y. 1974), aff'd 500 F.2d 1221 (2nd Cir. 1974), the Court in reference to a non-fiction text on the subject of child psychology recognized "It is hardly an inducement to [an author] to do the years of research and scholarship needed to produce an authoritative text if an untrained . . . writer . . . may paraphrase major portions and make a competing text out of it."

In *Miller v. Universal City Studios, Inc.* 650 F.2d 1365 (5th Cir. 1981), the Court was confronted with a claim of infringement of a book based on a sensational kidnapping and in its analysis relied on the idea/expression dichotomy to reach its result without the necessity of a separate rule for factual works. And in doing so stated "the line drawn between uncopyrightable facts and copyrightable expression of facts serves an important purpose in copyright law." *Miller, supra* at 1371.

In *Wainwright Securities, Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91 (2nd Cir. 1977), the Court found copyrightable subject matter in plaintiff's research reports of factual materials.

In *Schroeder v. William Morrow & Company*, 566 F.2d 3 (7th Cir. 1977), the Court found copyrightable subject matter in a gardening directory although the copying was not verbatim.

In *Flick-Reedy Corp. v. Hydro-Line Manufacturing Co.*, 351 F.2d 546 (7th Cir. 1965), cert. denied, 383 U.S. 958 (1966), the Court afforded copyright protection to a mathematical data and formula concerning hydraulic cylinders.

(d) The "Verbatim Rule" is Unnecessary to Protect the Free Flow of Ideas

The Court's reasoning does not support the conclusion that a Verbatim Rule is required. The touchstone of the Court's argument is the holding that "the degree of substantial similarity required to show infringement varies according to the type of work and the ideas expressed in it." (A5). In relying as it did on the case of *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) for the proposition that "the degree of substantial similarity required to show infringement varies according to the type of work and the ideas expressed in it", the Court of Appeals broadens the rule in the *Rosenthal* case beyond what is required. In *Rosenthal*, the Court first found that the idea and the expression were inseparable. Once that determination was made, it naturally followed that copying the work did not result in infringement since the copying of ideas cannot amount to infringement. The Court of Appeals below did not and could not conclude in the case at bench that the ideas and their expression were, in fact, inseparable. Thus the rule of *Rosenthal* is inapplicable.

In fact, the trial court in this case specifically accounted for the non-fictional nature of the work where it found:

> "27. The ideas expressed in the two works are substantially similar, as is to be expected in a non-fictional work dealing with a narrow subject where the range of choice for inclusion and exclusion is not large."

It then compared the expression and found:

> "42. The accused work contains no verbatim portions of the accusing work, but does constitute in significant part a paraphrase of it and contains the same substance, and was used as a model by S&R and was copied

by them. Defendants paraphrase of both language and theme of the accusing work is a crude effort to give the appearance of dissimilarity."

"43. The portions of the accused work summarized in Exhibit 45

(a) are substantially similar in their expressions to, and

(b) were copied from the corresponding portions of the accusing work therein summarized."

In other words, the trial court separated the ideas from their expression and then found the expression components substantially similar. In doing so it followed the well established analysis of prior cases, e.g. *Orgel v. Clark Boardman Co., supra*, at 120 and even of the Ninth Circuit before its announcement of the new Verbatim Rule of this case, Cf., *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corporation*, 562 F.2d 1157 (9th Cir. 1977) and the exact path of *Orgel, supra*.

The Court's Verbatim Rule that "similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed" (A7) is a confusing departure from the rule of other circuits. Having acknowledged that the similarity that is being analyzed is that of "expression" there is no benefit to the policy of free flow of ideas to apply a more stringent test to the expression in a non-fictional work than to that of a fictional work. Expression whether it be in the context of fiction or non-fiction is protectable and its vigorous protection promotes authorship without preventing the free flow of ideas.

The very application of its Verbatim Rule in the case at hand is an illustration of how the Rule works independent

of the policy of free flow of ideas and not in support of it. The Appeal Court observed:

> For example, Landsberg states that "[t]he poor player simply attempts to make as many points as possible each turn." The idea contained in that statement cannot be expressed in a wide variety of ways. Just about any subsequent expression of that idea is likely to appear to be a substantially paraphrase of words with which Landsberg expressed the idea." (A6-7).

The Court of Appeals incorrectly identified the "idea" as the entire statement. The "idea" contained in the statement is that one should pay attention to the defensive aspects of Scrabble in formulating a playing strategy. A myriad of ways exist to express that idea and Landsberg's expression is only one of them. Thus the Verbatim Rule invites the copying of expression along with ideas and thus discourages authorship. The Appeals Court referred to the "free flow of idea", but nowhere acknowledged the underlying public policy served by a vigorous enforcement of the copyright laws to all works. As this Court recently observed in *Sony Corp. v. Universal City Studios,* U.S. 1043, S.Ct. 774, 782, 78 L.Ed.2d 574 (1984):

> ". . . the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special regard, and to allow the public access to the products of their genius after the limited period of exclusive control has expired."

By creating and applying the Verbatim Rule, the Court turns aways from the difficult task of "attempting to distill the unprotected idea from the protected expression" (*Sid & Marty Krofft, supra,* at 1163). In doing so, the Ninth Cir-

cuit has created two classes of works in the eyes of the copyright law and relegated non-fictional works including those relating to science and useful arts to an inferior position.

CONCLUSION

For the foregoing reasons, a writ of certiorari should issue to review the judgment and opinion of the United States Court of Appeals for the Ninth Circuit.

Respectfully Submitted,

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(Appendices follow)

Appendix A

Nos. 80-6083, 82-5467, 82-5504.

United States Court of Appeals, Ninth Circuit.

Mark Landsberg, Plaintiff-Appellee,

v.

Scrabble Crossword Game Players, Inc.; Selchow & Righter Co.; and Crown Publishers, Defendants-Appellants.

Mark Landsberg, Plaintiff-Appellee-Cross-Appellant,

Crown Publishers, Inc.; Selchow & Righter Co.; and Scrabble Crossword Game Players, Inc., Defendants-Appellants, Cross-Appellants, Cross-Appellees.

Argued and Submitted April 8, 1983.

Decided March 5, 1984.

As Amended on Denial of Rehearing and Rehearing En Banc July 3, 1984.

H. Michael Brucker, Oakland, Cal., for Landsberg.

Walter D. Ames, Watson, Cole, Grindle & Watson, Washington, D.C., for defendants-appellants.

Appeal from the United States District Court for the Central District of California.

Before GOODWIN, TANG and FLETCHER, Circuit Judges.

GOODWIN, Circuit Judge:

Mark Landsberg recovered judgments of copyright infringement under California and federal law. Defendants appeal.

I. FACTS

Landsberg developed a systematic strategy for playing Scrabble and became the acknowledged Scrabble champion of Southern California. He committed his system to writing in a manuscript entitled "Championship Scrabble Strategy." In 1972 Landsberg took steps to publish the manuscript and requested permission to use the word "Scrabble" from Selchow and Righter (S & R), owner of the Scrabble trademark and producer of Scrabble brand crossword games. S & R requested that Landsberg send a copy of his manuscript to them for evaluation, and he did so.

S & R had been considering the preparation of a Scrabble Players Handbook and had hired an editor, but had developed nothing of substance at the time the Landsberg manuscript arrived. S & R immediately sent a copy of Landsberg's manuscript to Michael Senkiewicz, an expert Scrabble player, and asked that he evaluate Landsberg's work. Senkiewicz found on the whole that it was excellent. S & R then entered into a contract with Senkiewicz to produce a section on Scrabble strategy for the S & R Handbook. Part of the contract included an outline that the district court found Senkiewicz had copied from Landsberg's manuscript. Meanwhile, S & R entered into "negotiations" with Landsberg for rights in his manuscript, which the district court found were a bad faith tactic to keep Landsberg dangling while S & R was preparing its own Handbook based on Landsberg's work. Landsberg finally demanded that S & R return or destroy all copies of his

manuscript in S & R's possession. The district court found that S & R not only kept copies, but Senkiewicz used his copy of the manuscript as the basis for his section of the Scrabble Players Handbook. S & R severed its relationship with Landsberg shortly before S & R brought out its own Handbook.

Landsberg sued S & R, its subsidiary, Scrabble Crossword Game Players, Inc., and Crown Publishers in Los Angeles County Superior Court on several causes of action, including "piracy of literary property" (infringement of common law copyright) and breach of contract. Defendants successfully moved to have the case removed to United States District Court pursuant to 28 U.S.C. § 1441. After a blizzard of motions by S & R, many found obstructionist and frivolous by the district court, the court tried the case and rendered judgment for Landsberg on his common-law copyright cause of action.

In its findings of fact, the court found that denials of bad faith use of Landsberg's manuscript and copying from it by Senkiewicz and S & R were "not to be believed" and were "untrue." The court found that S & R at all times had access to Landsberg's manuscript, surreptitiously retained copies of it and engaged in wholesale copying of both Landsberg's ideas and the form of expression that he used in his manuscript.

Although S & R did not use verbatim portions of Landsberg's work, the trial court found that S & R had paraphrased a significant part of what Landsberg had written and created a Handbook substantially similar to Landsberg's manuscript. The court granted Landsberg actual and exemplary damages. It also awarded attorneys' fees and costs under 17 U.S.C. § 505 and the vexatious litigant rule.

S & R ignored the judgment and continued to sell and print its Handbook. Landsberg sued again for continuing copyright infringement, this time under the 1976 Copyright Act, Title 17 U.S.C., rather than California law because of the preemptive effect of 17 U.S.C. § 301(a). The court granted Landsberg summary judgment and damages, but denied his claim for further exemplary damages because there is no provision for such damages under the 1976 Copyright Act.

S & R appeals from both judgments of the district court. Landsberg appeals the denial of exemplary damages in his second action.

II. COPYRIGHT

A. *Applicable law.*

California law governs Landsberg's first action, because his claim states a cause of action arising from "undertakings commenced before January 1, 1978," 17 U.S.C. § 301(b)(2), and federal law governs Landsberg's second action, because it complains of infringement taking place after that date. But, at least as far as the question of infringement goes, it makes no difference which law applies. California appears to follow federal copyright cases on the question of infringement. *See, e.g., Weitzenkorn v. Lesser,* 40 Cal.2d 778, 256 P.2d 947, 956-957 (1953); *Stanley v. Columbia Broadcasting System,* 35 Cal.2d 653, 221 P.2d 73, 78 (1950); *Barsha v. Metro-Goldwyn-Mayer,* 32 Cal.App.2d 556, 560, 90 P.2d 371, 374 (1939). Neither Landsberg nor S & R have cited California cases to us on the question of infringement, relying instead on federal cases. Therefore we will assume that California law

parallels federal law on the question of infringement and analyze this case according to federal law.

B. *Infringement.*

To make out infringement, the plaintiff must establish that he owns the copyright in the work in question, that the defendant had access to the copyrighted work, and that there is "substantial similarity not only of the general ideas [of the works] but of the expression of those ideas as well." *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir.1977). In this case, it is undisputed that Landsberg owns the copyright in his work, and that S & R had access to it. The case turns on the issue of substantial similarity.

Similarity of expression must be established because it is an axiom of copyright law that copyright protects only an author's expression of an idea and not the idea itself. 17 U.S.C. § 102(b); *Mazer v. Stein*, 347 U.S. 201, 217-218, 74 S.Ct. 460, 470-471, 98 L.Ed. 630 (1954).[1] Corollary to this axiom is a strong policy permitting all to use freely the ideas contained in a copyrighted work so long as copyrighted expression is not appropriated.

One consequence of the policy in favor of free use of ideas is that the degree of substantial similarity required to show infringement varies according to the type of work and the ideas expressed in it. *Cf. Krofft*, 562 F.2d at 1167-68. Some ideas can be expressed in myriad ways, while others allow only a narrow range of expression. Fictional works

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[1]California law is in accord with federal law on this point. *See* former Cal.Civ.Code § 980 (West 1982); *Weitzenkorn v. Lesser*, 40 Cal.2d 778, 789, 256 P.2d 947, 956 (1953).

generally fall into the first category. The basic idea of a fictional work might be that classic, boy meets girl. This idea can be expressed, as it has been through thousands of years of literature, with infinite variations in setting, sequence of incident, and characterization. An author wishing to write yet another work using the "boy meets girl" idea can choose from a wide range of materials in composing his or her own expression of the idea. Therefore a new work incorporating that idea need not be a verbatim copy or close paraphrase of an earlier work to infringe that work. A resemblance in details of setting, incident, or characterization that falls short of close paraphrase may be enough to establish substantial similarity and infringement. *See, e.g., Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir.), *cert. denied*, 298 U.S. 669, 56 S.Ct. 835, 80 L.Ed. 1392 (1936). Similarly, the Krofft court noted that the defendants there could choose from myriad ways to create puppets that would express the idea contained in plaintiff's television series—"a fantasyland filled with diverse and fanciful characters in action." 562 F.2d at 1165. As a result, although defendants pointed to numerous differences between their puppets and plaintiff's, they were still held to be substantially similar.

Factual works are different. Subsequent authors wishing to express the ideas contained in a factual work often can choose from only a narrow range of expression. For example, Landsberg's work states that "[t]he poor player simply attempts to make as many points as possible each turn." The idea contained in that statement cannot be expressed in a wide variety of ways. Just about any subsequent expression of that idea is likely to appear to be a substantially similar paraphrase of the words with which Landsberg

expressed the idea. Therefore, similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed. 1 M. Nimmer, *Nimmer on Copyright*, § 2.11[A]-[B] (1968).

Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir.1980), *cert. denied*, 449 U.S. 841, 101 S.Ct. 121, 66 L.Ed.2d 49 (1980), illustrates this. Hoehling wrote a factual account of the destruction of the dirigible Hindenburg in which he theorized that Eric Spehl, a rigger on the Hindenburg, caused the explosion. Hoehling claimed that Universal had infringed his copyright by using his theory in a motion picture on the disaster. Universal's use of Hoehling's description of how Spehl sabotaged the Hindenburg might have been held a substantially similar infringement if Hoehling had written a fictional work. But because Hoehling's theory related to historical fact, Universal's use of it did not infringe so long as Universal did not "bodily appropriate" Hoehling's expression. 618 F.2d at 980. *See also Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981).

The doctrine of *scenes a faire* is another illustration of how the substantial similarity that constitutes infringement varies according to the idea expressed. Under that doctrine, a second author does not infringe even if he reproduces verbatim the first author's expression, if that expression constitutes "stock scenes or scenes that flow[] necessarily from common unprotectable ideas," *See v. Durang*, 711 F.2d 141, 143 (9th Cir.1983), because to hold otherwise would give the first author a monopoly on the commonplace ideas behind the *scenes a faire*.

C. *S & R's Handbook.*

We have reviewed Landsberg's work, S & R's work, and Exhibit 45, a comparative table of similarities between the two works. While we find similarities between the two works, we think there is no more than the similarity that must unavoidably be produced by anyone who wishes to use and restate the unprotectable ideas contained in Landsberg's work. If we were to hold S & R's work to be an infringement, we do not see how anyone could state Landsberg's ideas without also being held to have infringed. Landsberg would in effect have obtained a copyright on the ideas contained in his work.

The substantial similarity inquiry will vary according to the context in which it is applied. The copyright law protects expression of unprotectable ideas only insofar as is possible without protecting the ideas themselves. The district court therefore applied the substantial similarity test too broadly by expanding it to cover Landsberg's ideas and stock expressions.

S & R's work does not duplicate the selection, coordination, and arrangement of the ideas in Landsberg's work, so we need not decide whether a work that rephrased in the same order as the original a substantial part of the ideas in another work might be held to infringe that work as a compilation, *see* 17 U.S.C. §§ 101, 103, even though none of the rephrasings of the individual ideas would constitute infringement when viewed in isolation.

III. CONTRACT REMEDY

Landsberg cannot recover under the copyright laws, but he may have a remedy in California contract law. Landsberg alleged as his second cause of action that S & R had

breached a contract to pay him for the use of his Strategy Book. California law will enforce a contract, whether express or implied-in-fact, to pay for the disclosure of an uncopyrightable idea. *Weitzenkorn v. Lesser,* 40 Cal.2d at 790-791, 256 P.2d at 957-59; *Desny v. Wilder,* 46 Cal.2d 715, 299 P.2d 257 (1956).

The district court found as a fact that "[b]ased upon S & R's conduct, Plaintiff reasonably believed that S & R would not use or copy his manuscript, or any portion thereof, without his consent and without payment to him of an acceptable sum." This is conduct that can create an implied-in-fact contract. However, an implied-in-fact contract to pay for the conveyance of an idea will be enforced only if circumstances and conduct manifesting the terms and existence of a contract precede or attend disclosure of the idea. *Desny v. Wilder,* 46 Cal.2d at 738, 299 P.2d at 270. The district court made no findings on this point.

It is true that Landsberg's first disclosure of his manuscript to S & R, when he requested permission to use the Scrabble mark, apparently preceded any conduct on S & R's part indicating the existence of an implied-in-fact contract. However, we cannot hold as a matter of law that as a result no implied-in-fact contract was formed. Landsberg's initial disclosure of his manuscript to S & R may have been made in confidence, and if so, S & R's use of the disclosed ideas would have been wrongful. *Faris v. Enberg,* 97 Cal.App.3d 309, 158 Cal.Rptr. 704 (1979); *Davies v. Krasna,* 245 Cal. App.2d 535, 54 Cal.Rptr. 37 (1966); *Donahue v. Ziv Television Programs, Inc.,* 245 Cal.App.2d 593, 593, 54 Cal.Rptr. 130, 130 (1966) (dictum); *Thompson v. California Brewing Co.,* 150 Cal.App.2d 469, 310, P.2d 436 (1957). *See Davies v. Krasna,* 14 Cal.3d 502, 512, 535 P.2d 1161, 1167, 121 Cal.

Rptr. 705, 711 (1975). If Landsberg's original disclosure to S & R was in confidence, Landsberg cannot be said to have "blurt[ed] out his idea without having first made his bargain," *Desny*, 46 Cal.2d at 738, 299 P.2d at 279, and he should therefore not be held to have lost the opportunity to be the beneficiary of an implied-in-fact contract with S & R.

S & R's request for a second copy of Landsberg's manuscript may constitute conduct creating an implied-in-fact contract binding S & R to pay for Landsberg's ideas when used. *See Minniear v. Tors*, 266 Cal.App.2d 495, 504, 72 Cal.Rptr. 287, 294 (1968). We remand to the district court for further proceedings on Landsberg's breach of contract claim.

IV. OTHER ISSUES

A. *Exclusion of hearsay.*

S & R claims that at numerous points in the trial the judge erroneously sustained objections to hearsay. An analysis of each of the instances listed by S & R shows that the exclusions of hearsay were justified. In most of the cases, the testimony was directed at proving the truth of irrelevant allegations about Landsberg by quoting statements made by the witness to other persons out of court. In each case the witness could have been asked what Landsberg had done, not what the witness said he had said Landsberg had done. The objections to hearsay were properly sustained. Fed.R.Evid. 801(c), 802.

B. *Denial of motion to amend.*

S & R claims that the court erred in denying its motion to amend its answer one year after the final disposition in

the case was filed. The court's denial of the dilatory and futile motion was proper. *See PSG Co. v. Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 417 F.2d 559 (9th Cir.1969), *cert. denied*, 397 U.S. 918, 90 S.Ct. 924, 25 L.Ed.2d 99 (1970) (affirming denial of amendment 19 months after complaint had been filed). *Vickery v. Fisher Governor Company*, 417 F.2d 466 (9th Cir.1969) (affirming denial of amendment offered after entry of judgment).

C. *Findings of Fact.*

S & R asserts that the district court erred in using fact findings submitted by the winning side. It is true that the adoption of findings submitted by one of the parties necessitates close review of the facts by an appellate court, but it does not constitute reversible error unless the findings are clearly unsupported by substantial evidence. Here the findings, with the exception of those relating to substantial similarity, were supported by the evidence and both sides were permitted to file suggested findings and objections to findings. The court made its final choice of findings without undue prompting by either side. This was not reversible error. *Photo Electronics Corp. v. England*, 581 F.2d 772, 776-77 (9th Cir.1978).

D. *Statute of Limitations.*

S & R claims that Landsberg's copyright infringement action was barred by the two-year California statute of limitations because S & R published an article about the notational system it had taken from Landsberg in 1973, more than two years before Landsberg brought this action. Although we have held that Landsberg has no infringement remedy, we briefly discuss this issue because limitations

may also be an issue in Landsberg's contract cause of action on remand.

The two-year statute of limitations applies to an action on a contract not evidenced by a writing, such as Landsberg has alleged here. Cal.Code Civ.Proc. § 339 (West 1982). However, we cannot say that Landsberg's action is barred. First, it is not clear that S & R's limited use of Landsberg's notational system in a newsletter not distributed to the general public is the sort of use for which the alleged implied-in-fact contract between Landsberg and S & R contemplated payment. *See Donahue v. Ziv Television Programs, Inc.*, 245 Cal.App. at 611, 54 Cal.Rptr. at 141. If it is not, then the contract was not breached until S & R published its handbook, and Landsberg's suit was timely filed. Second, even if S & R did breach its contract with Landsberg when it used Landsberg's notational system in its newsletter, Landsberg may still be able to avoid the statute of limitations. He has alleged that S & R fraudulently engaged in bad faith negotiations for the rights to to his work. If this fraud prevented him from discovering S & R's use of his material in its newsletter, the statute of limitations was tolled until he discovered the fraud, or should have discovered it in the exercise of due diligence. *Sears, Roebuck and Co. v. Blade*, 139 Cal.App.2d 580, 294 P.2d 140 (1956).

E. *Attorney's Fees.*

S & R claims that the court erred in awarding Landsberg costs and attorneys' fees. Because we have held that there was no infringement, an award of attorneys' fees cannot be justified on the basis of the copyright statute. However, if on remand Landsberg prevails on his contract cause of

action, an award of attorneys' fees may well be justified by S & R's vexatious, oppressive, obdurate and bad faith conduct of this litigation. *Local No. 149 I.U., U.A., A. & A.I.W. v. American Brake Shoe Co.*, 298 F.2d 212, 214-215 (4th Cir.1962); *see Kelly v. Guinn*, 456 F.2d 100 (9th Cir. 1972), *cert. denied*, 413 U.S. 919, 93 S.Ct. 3048, 37 L.Ed.2d 1041 (1973).

The judgment is vacated and the cause is remanded to the district court for further proceedings on the plaintiff's claims other than copyright infringement.

Appendix B

District Court, C. D. California
Landsberg

v.

Scrabble Crossword Game Players, Inc. et al,

No. 76-2844

Decided Nov. 7, 1979

Paul S. Ferber, Los Angeles, Calif.,
for defendants.

Bolton & Gelbard, N. Hollywood, Calif.,
for Lee W. Tiffany

Waters, District Judge.

This is an action for common law infringement and breach of implied contract brought by plaintiff, Mark Landsberg, against corporate defendants, Selchow & Righter Company, Scrabble Crossword Game Players, Inc., and Crown Publishers, and against Lee W. Tiffany, a former employee at Selchow & Righter Company (S&R), and President of Scrabble Crossword Game Players, Inc. (Scrabble Game).

Jurisdiction is conferred on this court by 28 U.S.C. § 1441 and 28 U.S.C. § 1332, and venue by 28 U.S.C. § 1331.

Lee W. Tiffany settled during the course of the trial.

Issues Presented

The basic issues presented at trial were whether defendants substantially infringed plaintiff's manuscript by copying portions thereof and the nature and extent of damages suffered by plaintiff.

Discussion

A brief discussion of some of the important factors in this case is appropriate.

Plaintiff had written a draft of a handbook on the strategy and tactics of the game called "Scrabble" which game is owned by Selchow & Righter. Plaintiff, for the purpose of securing permission to use the name "Scrabble" in connection with the proposed publication of his manuscript, submitted a copy thereof to Selchow & Righter and Scrabble Crossword Game Players through the defendants' attorneys, Watson, Cole, Grindle & Watson.

Scrabble Game had been considering for some time the preparation of an updated replacement for an earlier volume on "Scrabble" and had undertaken some efforts in that direction including the collecting of materials and the hiring of an embryonic author. Nothing of substance, however, had been developed by October of 1972. The arrival of the Landsberg manuscript in November of 1972, therefore, was both fortuitous and timely.

It should be borne in mind that in the writing of a handbook on "Scrabble"—its tactics and strategy, the subject is exceptionally narrow and the range of choice as to what should be included, or excluded, is not large. Indeed the patte~n, both for substance and format, for any such volume has long been established through publications on such games as chess, checkers, dominoes, backgammon, etc.

The contents of such volumes, while perhaps sequentially arranged in differing orders, do not vary markedly from volume to volume. And within competing non-fictional works on the same subject matter, similarities in basic

theme, chapter content and jargon should be more often expected than unexpected. Lapsley v. American Institute of Certified Public Accountants, 246 F.Supp. 389, 391, 147 USPQ 439, 441-442 (D.D.C. 1965); McGraw-Hill, Inc. v. Worth Publishers, Inc., 335 F.Supp. 415 (S.D.N.Y. 1971). To sustain the contention of infringement the accusing work has the burden of demonstrating that it is not its ideas which have been pirated—for these are non-protectible (17 U.S.C. § 102(b) (1976))—but, rather, it must show that the particular manner in which the phrasing embodies the ideas in the offending work is the same as that in its originally expressed form or so closely paraphrased or so clumsily copied as to permit that "* * * crude effort to give the appearance of dissimilarity (to be) itself evidence of copying." Meir v. Albany Novelty, 236 F.2d 144, 111 USPQ 197 (2d Cir. 1956). There must be "substantial similarity" in the copying. This raises the further question of the scope of the word "substantial" in the context of a dispute such as this.

There is no precise line which may be drawn in determining at what point the infringement is substantial. It must be more than a slight portion of the accusing work. To the extent that there is any test to measure the degree of infringement, it would appear to be found in the rule laid down in Peter Pan Fabrics, Inc. v. Weinter Corp., 274 F.2d 487, 489, 124 USPQ 154, 155-156 (2d Cir. 1960):

> "The test for infringement of copyright is of necessity vague * * *. Obviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be ad hoc."

In the proof of copyright infringement cases, the traditional pattern is to demonstrate both access and similarity; and where there is strong evidence of access, less proof of similarity may suffice. Golding v. R.K.O. Pictures, Inc., 35 Cal.2d 690, 695, 82 USPQ 136 (1950); Sid & Marty Krofft Television v. McDonald's Corp., 562 F.2d 1157, 1172, 196 USPQ 97, 109-110 (9th Cir. 1977): "In this case, there is no dispute as to defendants' access to plaintiffs' work. Indeed, defendants were engaged in negotiations with plaintiffs for licensing of the (his) works," or so Landsberg thought.

It is undenied that notwithstanding the demand of plaintiff that all copies of hs manuscript be returned, defendants retained at least one copy and, presumably, retain that copy (or copies) even now. Defendants made the manuscript available to Michael Senkiewicz, author of the accused work. The denials of Senkiewicz of his use of the Landsberg manuscript are unpersuasive particularly in light of his admitted unfettered reliance upon other works and his critique that Landsberg's "• • • effort to systematize a workable and effective approach to playing Scrabble is • • • excellent and, on the whole, meritorious." It is worthy of note that Landsberg's notation system for the written expression of games played was the first time Senkiewicz had seen such a system for the game of Scrabble. Senkiewicz developed an alpha-numeric coordinate system of notation whereas plaintiff's system uses symbols over the played letters to properly place a word on a Scrabble board. But Senkiewicz did not develop his system until after he had studied plaintiff's, appreciated the merit in it, realized that a notation system for Scrabble was feasible, and then proceeded to establish the system which appears in the offending work.

Was this alpha-numeric system a disguised version of the plaintiff's system or an original creation by Senkiewicz? Defendant has argued that the alpha-numeric system of notation has long been in the public domain. Witness, for example, the international chess coordinate notational system. Other notational schemes can be found in the games of checkers and backgammon (not standardized). (Ex. B) While this is true, it is also true that until the plaintiff submitted his manuscript to defendants in connection with his solicitation to use the name of "Scrabble", no notational scheme or concept had been noted or developed by defendants. Defendants, in their notational version, do not copy plaintiff's system in identical or even in nearly identical fashion and thus it cannot be said that they have done more than imitate the "idea" of plaintiff's system rather than expropriating the detail thereof which is proscribed.

But "duplication or near identity is not necessary to establish infringement." (Sid & Mary Krofft Television v. McDonald's Corp., supra), and whether the accused notational system is found to be infringing or not, it provides a measure of flavor of the conduct of the defendants against which the credibility of their testimony and the instances of similarity may be weighed. As to two critical witnesses for the defendant, for example, the testimony of Michael Senkiewicz that he did not use or rely upon the plaintiff's manuscript, is simply not believable. Also, the testimony of Drue Conklin that she did not read the Landsberg draft is similarly unacceptable in light of the long expressed need of defendants that the absence of a current volume on

Scrabble seriously interfered with their promotional objectives and Ms. Conklin's responsibilities in connection therewith.

Whether there is substantial similarity between the accused and the accusing volumes is a significant question. As to format and contents, the question must be answered in the affirmative if for no other reason than the narrow and restricted nature of the basic subject matter itself. It appears to the court that while Mr. Senkiewicz is undoubtedly an expert Scrabble player, he is not equally adept as an author and, indeed, has no prior record in that regard. The earlier work on Scrabble entitled "How to Win at Scrabble," published in 1953 (Ex. BB) provided no help to Mr. Senkiewicz in establishing the format of his accused work including chapter headings and the contents thereof. Plaintiff's work, which the accused work parallels (although not precisely in the same order or sequence), does contain the same substance, was undoubtedly used as a model by Mr. Senkiewicz and others on behalf of defendants, and may be fairly said to have been copied by them.

While verbatim quotations from the accusing work are not found in the accused work, there is paraphrasing both of language and themes that obviously relates back to the Landsberg manuscript. Also the chapter breakdowns and the sub-parts thereof, and the manner of handling, are equally traceable to the accusing document.

Examples of copying that resulted in infringement are:

On page 2 of plaintiff's work, Landsberg states the following:

"The poor player simply attempts to work as many points as possible each turn."

On page 41 of the accused work, the following statement appears:

> "The player who sees no other aim in Scrabble Crossword Game than to score the maximum number of points, will never be a good player."

On page 13, the Landsberg manuscript states:

> "It is of negative value to make a 25 point play and leave an opening for your opponent to score an easy 30 points."

On page 41 of the accused work, we find:

> "It is useless to score 400 points a turn if an opponent will, as a consequence of that play, score considerably more."

At page 8, Landsberg states his strategy concerning the use of blank tiles. And on pages 8 and 9, he sets forth his rule for the use of blank tiles and then follows that rule with three exceptions

"A blank tile should never be used

[I] except in forming a bonus word."

"There are only three exceptions to this rule. The first is the unlikely case in which you are able to make a

[1] play of over 50 points by using the blank as an uncommon letter."

"The second exception occurs when

[2] you have drawn both blanks."

"The last exception is during the

[3] End Game when no openings for bonus words are available, as happens frequently."

Pages 73 and 74 of the accused work read:

"When a player draws a blank he should play a Bingo (Bonus Word) or

[I] develop his rack towards a Bingo (Bonus Word)."

"Sometimes (but not as often as you may think), a player with a blank cannot make a Bingo due to a rack full of high-valued tiles which don't combine well. In this particular

[1] instance when a player can make 40 plus points with high-valued tiles and a blank, he should do so."

"On rare occasions, a player is

[2] fortunate enough to pick up both blanks."

"The only exception to this is in the later stages of the game when

[3] there are no openings on the board for a Bingo (Bonus word)."

Landsberg makes this statement:

"The most important tiles in the game have no point value whatsoever—they are blanks."

The accused work quotes:

"The blanks are the most important tiles in the game."

Landsberg says of the letter "S":

"The use of an (S) in any other way is usually a waste of scoring potential unless, of course, it is used in a bonus word."

The accused work states:

"S's should not be wasted."

Landsberg states at page 2:

"This is instinctive and human but analogous to trying for a home run every time at bat and wearing no field's glove while the other team is batting."

The accused work responds:

"Therefore, the skilled SCRABBLE Crossword Game player resembles a boxer more than a slugger."

A more complete catalog of similarities may be found in Ex. 45.

Any one, two or even several of these items standing by themselves, or in small but identifiable groupings, may not be sufficient to justify a holding of copyright infringement but taken in their totality and in the context of

(1) the interest of defendants in producing a current volume on Scrabble to be used in conjunction with their promotional efforts,

(2) the timely arrival of the Landsberg manuscript in the office of the attorneys for S&R,

(3) the deception practiced by S&R in retaining a copy (copies) of the accusing work after negotiations had been broken off and plaintiff had made a demand for the return of all copies,

(4) the "access enjoyed by defendants to the accusing work during the course of the preparation of the accused work as a result of this deception,

(5) the fact that no significant work had been undertaken by defendants in preparation of the accused work until after they had received and had an opportunity to study the Landsberg manuscript, and

(6) the fact that the accused work was published in a relatively short time after "negotiations" between plaintiffs and defendants had terminated.

the only fair conclusion is that the defendants are guilty of unlawfully infringing the copyright of plaintiff.

Statute of Limitations

Defendants have asserted the statute of limitations as a bar to this cause and contend that if there was an infringement of plaintiff's copyright, it took place when defendants published their Newsletter in 1973 and since, as defendants urge, this was beyond the two-year statute of limitations which they say is applicable, plaintiff is time barred.

Plaintiff responds that he is seeking damages only for the publication of the Handbooks I and II, both of which were published within two years of the date of the filing of this action, and since the infringement of which they complain was and is continuing in nature (with which the court agrees), the action was timely filed and there is no necessity to resolve which of several sections may apply. The court finds that this action was timely filed and within two years of any act complained against. It is not necessary, therefore, to further discuss whether the three of four-year statutes may have applicability to the facts of this case.

Damages

Plaintiff is entitled to relief as follows:

(A) Damages in the amount of defendants' profits;

(B) Reasonable attorneys' fees;

(C) Costs;

(D) Exemplary damages in the amount of $100,000.00;

(E) No award for damages attributable to plaintiff's status and reputation as an author; and

(F) Injunctive relief against further printing or distribution of the accused work.

It Is Ordered that judgment be entered for the plaintiff and against the defendants. Counsel for the plaintiff are directed to prepare and submit memoranda showing the correct amount attributable to defendants' profits to date of judgment; time sheets or compilations thereof from which to compute reasonable attorneys' fees; and costs actually incurred and recoverable. Counsel for plaintiff are also directed to prepare and submit findings of fact, conclusions of law and judgment pursuant to Local Rule 7. (Judgment should be set forth as a separate document as required by Rule 58, F.R.Civ.P.)

Appendix C

District Court, C. D. California

Landsberg v. Scrabble Crossword Game Players, Inc. et al.

No. 76-2844

Decided Dec. 2, 1980

Action by Mark Landsberg, against Scrabble Crossword Game Players, Inc., Selchow & Righter Company, Crown Publishers, Inc. and Lee W. Tiffany, for copyright infringement and breach of contract. Damages assessed.

See also 212 USPQ 155.

H. Michael Brucker, Oakland, Calif., and Steven Kipperman, San Francisco, Calif., for plaintiff.

Paul S. Ferber, Los Angeles, Calif., for defendants.

Bolton & Gelbard, N. Hollywood, Calif., for Lee W. Tiffany.

Waters, District Judge

Introduction

This case presents an action for copyright infringement (CAL. CIV. CODE § 980, 17 U.S.C. §§ 301(a), 301(b)(2))[1] removed to this court as a case within the original diversity jurisdiction of this court.

In January, 1979, trial to the court was had. Plaintiff appeared at trial by H. Michael Brucker and by Friedman,

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[1]As used herein, copyright infringement refers to the common law right to make the first authorized publication of an original literary work.

Shawn, Kipperman & Sloan, P.C., by Steven M. Kipperman. Defendants Selchow & Righter Co. (S & R); Crown Publishers, Inc. (Crown); and Scrabble Crossword Game Players, Inc. (SCGP)[2] appeared at trial by Watson, Cole, Grindle & Watson by Walter Ames and Bernard Sweeney.[3]

The court having heard and considered all testimony offered (both live and by deposition), having read and considered all exhibits admitted in evidence, and having issued its Memorandum of Decision, now enters its Findings of Fact and Conclusions of Law as follows:

Findings of Fact

1. At the commencement and removal of this action, the amount in controversy exceeded the sum of $10,000.00, exclusive of interest and costs.

2. Plaintiff Mark Landsberg was, at the commencement and removal of and throughout this action, a citizen of the State of California over the age of 21 years.

3. Plaintiff is the author of an original, unpublished literary work entitled "CHAMPIONSHIP SCRABBLE STRATEGY" [hereafter the accusing work] (Exh. 1).

4. Plaintiff, at all material times, was and is the sole owner of the common law copyright in the accusing work.

5. Defendants Crown and S & R were, at the commencement and removal of and throughout this action, corpora-

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[2]SCGP was a wholly owned subsidiary of S & R and no contention was made that S & R did not control its actions. Hence, no distinction is drawn herein and, for convenience, both are collectively referred to as S & R unless otherwise indicated.

[3]At the commencement of trial, another Defendant, Lee Tiffany, settled with Plaintiff for $11,000,000.

tions incorporated in, and having their principal places of business in, states other than California.

6. Defendant S & R is the owner of the trademark "SCRABBLE" under which brand it markets several versions of its best-selling "Crossword Game", commonly known as the game of Scrabble.

7. Within two years of the commencement of this action in the Superior Court of the State of California, S & R published, for the first time, a literary work originally entitled SCRABBLE PLAYERS HANDBOOK (Exh. 2), which ultimately came to be known as the OFFICIAL SCRABBLE PLAYERS HANDBOOK [hereafter the accused work].[4] (Exh. 3). Prior thereto, no published work embodied protected portions of the accusing work.

8. Subsequent to S & R's publication, and within two years of the commencement of this action in the Superior Court of the State of California, Crown published for the first time the accused work, jointly with S & R.

9. The accused work as published by S & R alone was, for purposes of textual comparison, agreed by the parties and is found to be identical to the accused work as published by Crown and S & R.

10. Insofar as compensatory damages are concerned for the infringing publication S & R caused to be published, and Crown published, the accused work.

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[4]As to some portions of the accused work, no claim was made that they were copied from and infringed Plaintiff's rights in the accusing work. The strategy and tactics portion of the accused work is what these Findings and Conclusions refer to by the words "accused work"; that it, the part of the accused work dealing with how to play the game (excluding the rules).

11. Robert Rosegarten was an account executive at the advertising agency of S & R. Rosegarten acted at all material times as agent for S & R.

12. Michael Senkiewicz was an expert Scrabble player employed by S & R for the purpose of analyzing the accusing work and thereafter for preparing the accused work. Senkiewicz acted at all material times as agent for S & R.

13. Drue Conklin was an account executive at the advertising agency of S & R and was hired and acted as the editor of the accused work. Conklin acted at all material times as agent for S & R in connection with producing the accused work.

14. Lee Tiffany was a managerial level employee of S & R generally in charge of and responsible for producing and publishing the accused work. Tiffany acted at all material times as agent for S & R within the course and scope of his employment.

15. Plaintiff, in 1972, intended to publish the accusing work.

16. Plaintiff sent a copy of the accusing work to S & R for the purpose of securing permission to use the name "Scrabble" in connection with his proposed publication.

17. S & R, at the time it received the copy of the accusing work from Plaintiff, had been considering for some time the preparation of an updated replacement for an earlier volume on "Scrabble" and had undertaken some efforts in that direction including the collecting of materials and the hiring of an embryonic author. Nothing of substance, however, had been developed by October, 1972. The arrival of the accusing work in November of 1972, therefore, was both fortuitous and timely.

18. Shortly after receiving the accusing work, Tiffany provided a copy to Senkiewicz and requested him to report his opinion of it to S & R.

19. Senkiewicz studied and analyzed the accusing work in detail and reported to S & R that the accusing work was "excellent and, on the whole, meritorious" (Exh. 18).

20. The denial by Tiffany of his interest in, appreciation for, and desire to publish the accusing work is not believed by the court and is found to be untrue.

21. (a) After receipt of the accusing work, S & R, through Tiffany and Rosegarten, conducted "negotiations" with Plaintiff for rights in the accusing work.

(b) Although appearing to negotiate, S & R never made an offer of terms on which an agreement could be based but continually led Plaintiff to believe that such terms would be forthcoming.

22. Based on S & R's conduct, Plaintiff reasonably believed that S & R would not use or copy his manuscript, or any portion thereof, without his consent and without payment to him of an acceptable sum. Defendants at no time have obtained Plaintiff's consent to their use or copying of the accusing work and at no time have paid or tendered any payment to Plaintiff.

23. After many months of "negotiations", Plaintiff demanded the return or destruction of all copies of the accusing work in S & R's possession.

24. After receipt of Plaintiff's demand for said return or destruction, no one at S & R requested that Senkiewicz return the copy of the accusing work previously supplied to him by Tiffany.

25. S & R at all times had access to the accusing work and surreptitiously retained one or more copies thereof, notwithstanding Plaintiff's demand for their return or destruction.

26. After Plaintiff terminated "negotiations" with S & R, S & R employed Senkiewicz to produce the accused work and Conklin to be the editor.

27. The ideas expressed in the two works are substantially similar, as is to be expected in a non-fictional work dealing with a narrow subject where the range of choice for inclusion and exclusion is not large.

28. Senkiewicz had no prior history of original authorship or demonstrated writing skills.

29. At all times while engaged in the production of the accused work, Senkiewicz maintained in his apartment, where he allegedly authored the accused work, a copy of the accusing work.

30. Senkiewicz engaged in free, unfettered and indiscriminate copying from other copyrighted works in preparing the accused work.

31. Senkiewicz produced an outline for the accused work shortly after studying in detail the accusing work (E.g., Exh. 53).

32. Senkiewicz's outline was copied from the accusing work.

33. The denial by Senkiewicz that he used and copied from the accusing work is not believed by the court and is found to be untrue.

34. The denial by Conklin that she read the accusing work before publication of the accused work is not believed by the court and is found to be untrue.

35. No source of information on how to play the game of Scrabble, other than the accusing work, was used by S & R in producing the accused work. Mr. Senkiewicz was identified as an expert in the game of Scrabble.

36. Exhibit AK contains a detailed synopsis of the accusing work.

37. Exhibit AK was used by S & R in producing the accused work.

38. The accusing work contains an original and novel idea [hereafter Plaintiff's notational system] for expressing a past-played game of Scrabble.

39. The idea of Plaintiff's notational system is not within the scope of copyright protection.

40. S & R copied and modified Plaintiff's notational system and this conduct is evidence of their propensity to copy from the accusing work and hence is evidence of copying the protected expression in the accusing work, as well as evidence bearing upon the credibility of denials of copying.

41. S & R copied both ideas and the form of expression from the accusing work.

42. The accused work contains no verbatim portions of the accusing work, but does constitute in significant part a paraphrase of it and contains the same substance, and was used as a model by S & R and was copied by them. Defend-

ants paraphrase of both language and theme of the accusing work is a crude effort to give the appearance of dissimilarity.

43. The portions of the accused work summarized in Exhibit 45

(a) are substantially similar in their expression to, and

(b) were copied from the corresponding portions of the accusing work therein summarized.

44. The accused work is substantially similar to the accusing work.

45. Plaintiff has proved copying, by a preponderance of the evidence by several independent means ((a) through (e) below), each of which persuades this court that the accused work was copied from the accusing work, to wit:

(a) The untruthful denial of copying by Senkiewicz;

(b) The admission by Senkiewicz that in producing the accused work he used Exhibit AK which contains notes sufficient to disclose to Senkiewicz the expression used in the accusing work;

(c) The undisputed continuing access to the accusing work and the substantial similarity between the accused and accusing works as exemplified in Exhibit 45;

(d) (1) Senkiewicz's production of his initial outline for the accused work shortly after studying in detail the accusing work, and not, as he testified, several months thereafter (see Exh. 53);

(2) Senkiewicz's creation of his first outline for the accused work by copying from the accusing work, and

not, as he testified, by reference to books dealing with other games;

(3) Senkiewicz's free, unfettered and indiscriminate copying from other copyrighted works;

(4) Senkiewicz's lack of prior history of original authorship or demonstrated writing skills;

(5) Senkiewicz's possession of a copy of the accusing work in the very apartment where he allegedly produced the accused work and his untruthful statement that he never referred to it while producing the accused work;

(6) Senkiewicz's early admission that the accusing work was "excellent, and on the whole, meritorious";

(e) Considering the similarities of expression summarized in Exh. 45—recognizing that any one, two or even several of the items standing by themselves, or in small but identifiable groupings, may not be sufficient to justify a holding of copyright infringement—taken in their totality and in the context of all of the facts and circumstances surrounding the desire and motive of S & R to produce a work like the accusing work including

(1) The interest of Defendants in producing a current volume on Scrabble to be used in conjunction with their promotional efforts (Exh. 5);

(2) The timely arrival of the Landsberg manuscript in the office of the attorneys for S & R;

(3) The deception practiced by S & R in retaining a copy (copies) of the accusing work after negotiations had been broken off and Plaintiff had made a demand for the return of all copies;

(4) The access enjoyed by S & R to the accusing work during the course of the preparation of the accused work as a result of this deception;

(5) The fact that no significant work had been undertaken by S & R in preparation of the accused work until after they had received and had an opportunity to study the Landsberg manuscript; and

(6) The fact that the accused work was published in a relatively short time after "negotiations" between Plaintiff and S & R had terminated;

the only fair conclusion is that the Defendants are guilty of unlawfully infringing the copyright of Plaintiff.

46. The ordinary reasonable person would find substantial similarity of expression between the accusing and accused works.

47. The ineluctable finding from all of the findings and circumstances set forth in the Findings of Fact Nos. 45-46 is that S & R violated Plaintiff's copyright and lied about doing so.

48. The accused work usurped the value and commercial worth of the accusing work in that, inter alia, it was so similar in idea and expresion as to deprive the accusing work of a viable commercial market.

49. Without the protectible portions copied from the accusing work, the accused work would have no appreciable value.

50. Exhibit BH (Newsletter) was first published within three years of the commencement of this action. Said News-

letter contains no significant protected matter from the accusing work.

51. Plaintiff has not carried his burden of proof that the infringement without authorship credit injured his reputation.

52. The sales of the accused work realized by Defendants through 12/31/78 were $147,194.07.

54. The cost of manufacturing copies of the accused work, paid through 12/31/78, was $60,107.60.

58. The acts and conduct of S & R's agents constituting deliberate copyright infringement (a) were known to managerial level employees of S & R who had the duty and responsibility to oversee the production and publication of the accused work, (b) were known or should have been known to be acts of deliberate copyright infringement prior to publication of the accused work, and/or (c) were authorized by Tiffany, a managerial level employee of S & R in connection with producing the accused work.

59. The acts and conduct of Senkiewicz were directed by S & R's managerial level employee (Tiffany) in the course and scope of Tiffany's employment.

60. Tiffany had control and decision-making authority over production of the accused work.

61. The copying and infringement by S & R of the accusing work was knowing, intentional, deliberate, malicious and oppressive.

62. S & R had the motive and willingness to vex, harass, and injure Plaintiff.

63. Tiffany acted in reckless disregard of the rights of Plaintiff in his conduct with regard to the accusing work (e.g., providing it to Senkiewicz without Landsberg's prior consent; not securing its return from Senkiewicz after demand therefor and at a time when S & R had asked Senkiewicz to prepare a similar work.)

64. S & R, as recently as 1975, had a net worth of approximately $10,000,000.00 (Exh. 58).

65. Exemplary damages of $100,000.00 are necessary to punish S & R for its wrongful conduct and are reasonable and not excessive.

66. Defendants Crown and S & R conducted their defense jointly through their attorneys.

67. Plaintiff, before retaining present counsel, tried unsuccessfully to secure other counsel in a respected Los Angeles law firm to take the case on a contingent fee basis. They declined to take the case on such terms.

68. The Copyright Act of 1976 became effective during the pendency of this litigation.

69. The subject matter of this action would be within the Copyright Act of 1976 had the accusing work been created on or after January 1, 1978.

70. Plaintiff and his counsel have vindicated an important public policy of redressing deliberate and intentional piracy of an original literary work.

71. Defendants attempted to and did litigate this case in such a manner as to oppress Plaintiff and his counsel, attempted to and did unnecessarily and unreasonably increase the expense and time required to be devoted to this

litigation knowing that Plaintiff lacked adequate financial resources to pay the costs of the litigation on a current basis as it was conducted by Defendants, attempted to and did frustrate Plaintiff's legitimate discovery, filed numerous unmeritorious motions, opposed numerous meritorious motions, sought on at least two occasions to repudiate stipulations previously entered into, and in general demonstrated an unwillingness to conduct the litigation in a reasonable manner.

72. Plaintiff's counsel undertook this action on a contingent fee basis and agreed to advance all costs and expenses knowing the case to have a substantial risk factor.

73. Plaintiff's counsel conducted the litigation as reasonably and efficiently as practical given the conduct of Defendants and their counsel.

74. Plaintiff's counsel were well prepared on all issues, factual and legal, evidencing significant preparation and organization, and conducted the litigation with demonstrated expertise which justifies their hourly rates.

75. Plaintiff's counsel devoted 1967.75 hours to this case through November, 1979, all of which time was reasonable and necessary, 1026.75 hours by H. Michael Brucker, 847.875 by Steven M. Kipperman (8.5 of which was by a partner of his), 2.5 by an associate of his, and 90.625 by a law clerk of his.

76. H. Michael Brucker's current hourly rate for litigation of this type is $100/hour.

77. Steven M. Kipperman's current hourly rate for litigation of this type is $120/hour, his associate's is $80/hour, and his law clerk's is $35/hour.

78. (a) Plaintiff necessarily and reasonably incurred total costs and expenses through November, 1979 of $21,092.18, consisting of:

(i) $288.03 marshal and process server fees

(ii) $43.00 clerk fees

(iii) $310.00 witness/mileage fees

(iv) 6473.02 deposition/transcript costs

(v) $10436.51 travel and expenses related to deposition and court attendance

(vi) $1522.88 office copying costs

(vii) $1028.54 copies of transcripts and exhibits for use at trial

(viii) $960.20 special postage, messenger, and long distance phone

(b) Of this sum, $7114.05 would be recoverable in any type of action and said sum is allowed herein to Plaintiff consisting of

(i) $331.03 in clerk, marshal, and process server fees

(ii) $310.00 in witness fees

(iii) $6473.02 in deposition transcripts and copies for use at trial

(c) Under either Section 505 of the Copyright Act of 1976, or decisions conferring discretion on the court in this type of case to allow recovery of additional or "full" costs and expenses actually incurred, the additional sum of $11,275.63 is awarded to Plaintiff consisting of

(i) $9936.51 incurred in travel in connection with taking depositions and attendance at court hearings

(ii) $1339.12 representing the costs of additional copies of deposition transcripts and exhibits for use at trial ($310.58 incurred "in office" and $1028.54 outside).

79. (a) Defendants, pursuant to prior court order, have already paid Plaintiff's counsel the sum of $825.00 representing sanctions partly for costs and partly for time.

(b) Plaintiffs are further entitled to recover $1798.20 as costs incurred since Dec. 31, 1979.

Conclusions of Law

1. The amount in controversy in this case at all times exceeded $10,000.00, exclusive of interest and costs.

2. The court has subject matter jurisdiction of the action pursuant to 28 U.S.C. § 1441(a) (removal jurisdiction) and 28 U.S.C. § 1332 (original diversity jurisdiction).

3. Venue is proper in the Central District of California pursuant to 28 U.S.C. § 1391(a) (Plaintiff resides here) and 28 U.S.C. § 1441(a) (district where removed action was pending).

4. Plaintiff has affirmatively carried his burden of proof, independent of any failure by Defendants in the production of any evidence, on all material issues of fact, including without limitation:

(a) ownership of the common law copyright in the accusing work;

(b) access and copying by Defendants;

(c) publication of an infringing work by Defendants;

(d) intentional and deliberate infringement by S & R;

(e) the amount of exemplary damages;

(f) Defendants' profits;

(g) Plaintiff's right to attorney fees.

See John L. Perry Studio, Inc. v. Wernick, 597 F.2d 1308 (9th Cir. 1979).

5. Plaintiff's notational system is not itself protected by his common law copyright.

6. The publication of the accused work is an infringement of Plaintiff's common law copyright in the accusing work.

7. Plaintiff's action and the relief requested are not time barred by C.C.P. § 339(1).

8. Crown is liable to Plaintiff for copyright infringement due to its publication and dissemination of the accused work, notwithstanding its lack of actual intent to infringe (Plymouth Music Co. v. Magnus Organ Corp., 456 F. Supp. 676, 203 USPQ 268 (S.D. N.Y. 1978)).

9. Crown and S & R, on account of their copyright infringement and conduct of the litigation, are jointly and severally liable to Plaintiff for their profits, attorney fees, and costs; and are each subject to injunction and an accounting.

10. No allocation of Defendants' profits as between infringing and non-infringing parts of the accused work is proper in this case.

11. Plaintiff is entitled to recover Defendants' profits; to wit, proved gross sales of copies of the accused work less proved expenses attributable to producing and selling those copies.

12. Plaintiff is entitled to recover Defendants' established profits in the sum of $87,086.47.

13. Defendants must account to and pay to Plaintiff all gross sales not included in Finding of Fact Nos. 52 and 53, said accounting to be by verified declaration, with supporting documentation, within thirty (30) days hereof.

14. On the facts of this particular case, it is equitable to impose a constructive trust upon Plaintiff's literary work—and all profits derived therefrom, regardless of source—which literary work Defendants wrongfully detained, appropriated, exploited, used, and copied.

15. Plaintiff is not entitled to any award of damages for loss of reputation.

16. Plaintiff is entitled to punitive damages, CAL CIV. CODE § 3294; Williams v. Wisser, 273 Cal.App.2d 726 (1969), from S & R.

17. (a) Crown is not liable for punitive damages.

(b) S & R is liable for punitive damages.

18. Plaintiff is entitled to recover costs in the sum of $20,187.88. (Items (b) and (c) in Finding of Fact No. 78 and Finding of Fact No. 79(b) (cf., Mailer v. Teleradio Pictures, Inc. 332 F.2d 747, 749, 141 USPQ 462, 464 (2d Cir. 1964)).

19. Plaintiff is entitled to reasonable attorney fees independently on either of the following grounds:

(a) Section 505 of the Copyright Act of 1976 applies to this case by virtue of Sections 301(a) and 302(b)(2) of said Act, there being no statutory direction to the contrary, cf., Walt Disney Productions v. Air Pirates,

581 F.2d 751, 754, 199 USPQ 769, 771-772 (9th Cir. 1978); or

(b) Defendants' conduct of this litigation was unnecessary, unreasonable, vexatious, oppressive, obdurate, and in bad faith within the meaning of cases such as County of Inyo v. City of Los Angeles, 78 Cal.App. 3d 82, 91-93 (1978); Local No. 149 . . . v. American Brake Shoe Co., 298 F.2d 212, 214 (4th Cir. 1962); Kelly v. Guinn, 456 F.2d 100 (9th Cir. 1972).

22. Plaintiff is entitled to an award of reasonable attorney fees in the sum of $233,026.27.

23. Plaintiff is entitled to an injunction restraining Defendants from printing, selling, or distributing, the accused work or any work derived therefrom; or otherwise infringing Plaintiff's copyright and such ancillary relief as will effectuate said injunction.

24. Plaintiff is entitled to an accounting of any profits realized by Crown and S & R from the accused work which profits are not reflected in Findings of Fact Nos. 52 & 54.

Appendix D

United States Court Of Appeals
For The Ninth Circuit

No. 80-6083

DC No. 76-2844

Mark Landsberg,
Appellee,

v.

Scrabble Crossword Game Players, Inc.,
Selchow & Righter Co., and Crown Publishers,
Appellants,

Nos. 82-5467, 82-5504

DC No. 81-2016

Mark Landsberg,
Appellee,

v.

Crown Publishers, Inc., Selchow & Righter Co.,
and Scrabble Crossword Game Players, Inc.,
Appellants.

Filed July 3, 1984

ORDER

Before: GOODWIN, TANG and FLETCHER

The order entered herein May 8, 1984, is set aside and the following substituted:

On slip page 1222, first column, before first full paragraph, (page 8, line 15, of typewritten opinion), insert the following new paragraph:

> The substantial similarity inquiry will vary according to the context in which it is applied. The copyright law protects expression of unprotectible ideas only insofar as is possible without protecting the ideas themselves. The district court therefore applied the substantial similarity test too broadly by expanding it to cover Landsberg's ideas and stock expressions.

On slip page 1223, second column, fifth line from top (page 11, line 17, of typewritten copy), insert after the word "findings": ", with the exception of those relating to substantial similarity."

The petitions for rehearing are denied and the suggestion for rehearing en banc is rejected.

84-586

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No. 84-____

IN THE

Supreme Court of the United States

OCTOBER TERM, 1984

MARK LANDSBERG,

Petitioner,

VS.

SCRABBLE CROSSWORD GAME PLAYERS, INC.; SELCHOW & RIGHTER, CO.; AND CROWN PUBLISHERS,

Respondents.

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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3 Nimmer on Copyright § 13.03[A] (1984 ed) 8

I. INTRODUCTION

Respondents, Scrabble Crossword Game Players, Inc., Selchow & Righter Company and Crown Publishers, Inc., who were the defendants in the district court and appellants in the court of appeals, have no substantive dispute with those portions of the petition entitled, Opinion Below, Jurisdiction, and Constitutional and Statutory Provisions. They have definite and overwhelming objection to petitioner's Statement of the Case and Statement of Facts. Indeed, the latter exalts the district judge's findings above the court of appeal's decision. Perhaps the reason that petitioner Landsberg likes those findings is that they were prepared by his counsel, and wholeheartedly adopted by the trial court.

II. STATEMENT OF THE CASE

This case, the first complaint in which was filed in 1976, will not be reviewed in excruciating detail. With extreme brevity, respondent Selchow & Righter Company makes and sells the Scrabble-brand crossword game. In 1972 the petitioner, Mr. Landsberg, sent Selchow & Righter's public relations subsidiary, Scrabble Crossword Game Players, Inc., a copy of an unpublished manuscript ostensibly prepared by Mr. Landsberg. That manuscript has never found a publisher. It contains but 25 pages of actual copy. Mr. Landsberg sent Scrabble the manuscript to see if respondents had any objection to Landsberg's use of the trademark SCRABBLE therein.

Respondents had been considering the preparation of an updated replacement for its 59-page volume entitled, How To Win At Scrabble, published in 1955. After receiving Landsberg's unsolicited manuscript, some sporadic negotia-

tions ensued regarding Mr. Landsberg's authoring a new version of How To Win At Scrabble. Those negotiations broke down, and Scrabble Crossword Game Players, Inc. employed a recognized Scrabble crossword game authority to prepare its own book, which was subsequently published under the title, Scrabble Players Handbook.

The accused Scrabble Players Handbook is 146 pages in length, replete with photographs, and is completely dissimilar in appearance—and respondents submit in content—to the scanty manuscript Mr. Landsberg sent to respondents. There was never a question of access: respondents admitted access. So, the only issue was substantial similarity.

III. THE COURT OF APPEALS HOLDING REGARDING SUBSTANTIAL SIMILARITY

A unanimous decision of the U.S. Court of Appeals was rendered on March 5, 1984 and is found in Appendix A (A-1 to A-13) bound with the Petition. Commencing at A-4, the court of appeals carefully and at length considered the question of infringement, and particularly whether there was substantial similarity between the works. With citation to prior decisions of this Court, the U.S. Courts of Appeals for the Ninth, Second and Fifth Circuits, state courts and an authority on the copyright law, the court of appeals determined that between Landsberg's manuscript and respondent's Scrabble Players Handbook there was no substantial similarity, saying at A-8:

> While we find similarities between the two works, we think there is no more than the similarity than must unavoidably be produced by anyone who wishes to use

and restate the unprotectable ideas contained in Landsberg's work. If we were to hold S&R's work to be an infringement, we do not see how anyone could state Landsberg's ideas without also being held to have infringed. Landsberg would in effect have obtained a copyright on the ideas contained in his work.

* * *

S&R's work does not duplicate the selection, coordination, and arrangement of the ideas in Landsberg's work, so we need not decide whether a work that rephrased in the same order as the original a substantial part of the ideas in another work might be held to infringe that work as a compilation, *see* 17 U.S.C. §§ 101, 103, even though none of the rephrasings of the individual ideas would constitute infringement when viewed in isolation.

IV. PETITIONER'S REASONS FOR THIS COURT'S GRANTING CERTIORARI ARE INAPT

Petitioner urges that certiorari should be granted because the court of appeals fashioned a new rule of law for works of nonfiction, which petitioner calls the "verbatim rule" and which, avers petitioner, would virtually exclude factual works from copyright protection. According to petitioner, the court of appeals "for the first time" has established this "verbatim rule." Further, says petitioner, other circuits do not have any such verbatim rule.

Petitioner is in error on two counts: (1) there was no "verbatim rule" established by the Ninth Circuit and (2) other circuits certainly do recognize that there is a difference in adjudicating substantial similarity when consid-

ering factual and nonfactual works. This distinction springs from the recognition that in factual works dealing with the same subject matter, there must of necessity be some similarity of expression, since the non-protectable ideas on which the expressions are based are often the same.

A. No Verbatim Rule Was Established By the Ninth Circuit Court of Appeals

In petitioner's Questions Presented, an attempt is made to create a false issue, *i.e.*, the asserted utilization of a new legal standard for a determination of infringement of factual versus nonfactual works. Contrary to petitioner's assertion, the appellate court used the universal and established legal standard in the assessment of copyright infringement—ownership of a right, access to the accusing work, and a comparative assessment of the substantial similarity of the expressions of ideas in the subject works. *Sid & Marty Krofft Television Productions, Inc.* v. *McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

The petitioner suggests the appellate court has fashioned a new test for the assessment of substantial similarity between nonfactual works: the contrived "verbatim rule." The appellate court did not establish a verbatim rule; it merely outlined existing discretionary parameters for evaluating substantial similarity in various types of works on a case-by-case basis.

A primary fact to bear in mind in this copyright infringement action is that the works at issue both relate to common factual subject matter, *i.e.*, tactics and strategies for playing respondents' SCRABBLE crossword game. Recognizing the commonality of factual subject matter for the works at issue, the Ninth Circuit stated, "Subsequent authors wish-

ing to express the ideas contained in a factual work often can choose from only a narrow range of expression" [A-6]. Then, quoting from *Nimmer on Copyright*, it made the statement which forms the entire basis for the Petition:

> Therefore, similarity of expression *may* have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed. [A-7] [emphasis supplied]

The petitioner attempts to create an issue herein by conversion of the discretionary language used by the appellate court to the purported "verbatim rule." This deft, albeit self-servingly erroneous, conversion is evidenced at page 3 of the Petition;

> The Court of Appeals for the Ninth Circuit reversed, holding that "similarity of expression *may* have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed." (A-7). Based on its review of the two works involved the Court of Appeals concluded that there was not the *requisite* verbatim reproduction or very close paraphrasing necessary for infringement of a "factual" work. (A-8) [emphases supplied]

A like modification of the discretionary language of the appellate court decision appears at page 9 of the Petition:

> By fashioning a rule of law for works of nonfiction *requiring* verbatim or near verbatim copying of expression . . ." [Emphasis supplied]

This attempted refashioning of the appellate court decision to create an imagined conflict in the circuits does not past

even cursory analysis of the case law and review of subsequent portions of the appellate court opinion.

The appellate court concluded that the degree of similarity between the works was an "unavoidable consequence" of the commonality of the subject matter. However, it did not limit its review to substantial similarity in expression or rephrasing of the expressions of the subject works, *i.e.*, the purported verbatim rule. It separately reviewed the selection, coordination, and arrangement of the accused work as a second possible basis to support a finding of substantial similarity and concluded:

> [Respondents'] work does not duplicate the selection, coordination, and arrangement of the ideas in [petitioner's] work, so we need not decide whether a work that rephrased in the same order as the original a substantial part of the ideas in another work might be held to infringe that work as a compilation, *see* 17 U.S.C. §§ 101, 103, even though some of the rephrasings of the individual ideas would constitute infringement when viewed in isolation. [A-8]

The court below tried to find some basis to support the district court's holding of copyright infringement—and failed.

B. The Ninth Circuit Followed Established Precedent for Analysis of Substantial Similarity for Factual Works, and, Analogously, Scenes A Faire

The appellate court merely recognized the obvious. For fictional works having an infinite variety of expressions, and factual works having a narrow range of expressions of a

given idea, the closeness of expression requisite to a finding of substantial similarity may vary.

The petitioner specifically recognized this wide discretionary latitude at page 11 of the Petition, stating:

> Every copyrighted work necessarily has a different blend of idea and expression varying from the work in which the idea so dominates that there is no independent expression (Cf., *Herbert Rosenthal Jewelry Corp.* v. *Kalpakian*, 446 F.2d 738 (9th Cir. 1971) to the work of fantasy where the idea provides only the most general theme and all the rest is expression (Cf., *Universal Film Studios* v. *Film Ventures International*, 543 F.Supp. 1134 (C.D. Cal. 1982)).

In the present case, the two texts, both describing how to play respondents' SCRABBLE crossword board game, must have some innocent similarities because they must express many similar ideas. To activate the presumption of copying, greater similarity may be required for factually based works than fictional works. In the latter the author can choose from an infinitely variety of expressions. This similarity may have to rise to the level of verbatim copying or very close paraphrasing if the modes for expression of the common subject matter are narrow.

This variable discretion in the application of the substantial similarity test to factual works is well established and recognized. *Hoehling* v. *Universal City Studios, Inc.*, 618 F.2d 972, 979-980 (2d Cir. 1980); *Wainwright Securities, Inc.* v. *Wall Street Transcript, Corp.*, 558 F.2d 91 (2d Cir. 1977); *Suid* v. *Newsweek Magazine*, 503 F.Supp. 146, 148 (D.C.D.C. 1980); 3 *Nimmer on Copyright* § 2.11[B]. The

rationale for this application of the substantial similarity test to factual works was cogently addressed by the appellate court in its opinion at A-5 to A-7.

Additionally, the appellate court at A-7 discussed the doctrine of *scenes a faire* as "another illustration of how the substantial similarity that constitutes infringement varies according to the idea expressed." This doctrine recognizes that reproduction of an author's expression of stock scenes, or scenes that flow necessarily from common, unprotected ideas, does not constitute infringement. To hold otherwise would give the first author of a stock scene a monopoly on commonplace ideas behind the *scenes a faire*.

The doctrine of *scenes a faire*, as initially promulgated by Judge Yankwich in *Schwarz* v. *Universal Pictures Co.*, 85 F.Supp. 270, 275 (S.D. Cal. 1945), is established precedent, as indicated by the copious notation of cases at 1 *Nimmer on Copyright* § 13.03[A] n. 43, 44. Does petitioner suggest that the appellate court established new law by its reference to this doctrine?

C. Petitioner's Cited Law Supports Respondents' Position

The petitioner has cited a number of cases commencing at page 12 of its Petition in an attempt to demonstrate a conflict among the circuits. Since petitioner has fabricated a new rule of law requiring verbatim copying in copyright actions involving factual works, such a purported conflict would not be surprising. However, petitioner's cited case law utilizes the same discretionary, analytical approach followed by the Ninth Circuit in the instant case.

The first case on which petitioner relies is *Orgel* v. *Clark Boardman Co.*, 301 F.2d 119, 120 (2d Cir. 1962), where the

court noted that two factual texts treating the same subject matter are bound to contain a large measure of innocent similarity. The *Orgel* court found infringement but no verbatim copying, although it did find similarity of phrasing. However, the court then proceeded to a second test of substantial similarity: the selection, coordination and an arrangement of ideas, and held:

> "When the books are read together in continuity the content is so similar in arrangement, in the language and in substance that the conclusion is inescapable that the individual defendant took advantage of his access to the individual's plaintiff's [sic] book in the compilation of the part of his work which dealt with valuation." [301 F.2d 120]

That is precisely what the Ninth Circuit did in the case at bar. At A-8 the Ninth Circuit held:

> S&R's work does not duplicate the selection, coordination, and arrangement of the ideas in Landsberg's work, so we need not decide whether a work that rephrased in the same order as the original a substantial part of the ideas in another work might be held to infringe that work as a compilation, see 17 U.S.C. §§ 101, 103, even though none of the rephrasings of the individual ideas would constitute infringement when viewed in isolation.

Thus, the Second Circuit in *Orgel* and the Ninth Circuit in the present action took precisely the same path in determining substantial similarity or lack thereof.

Nutt v. *National Institute*, 31 F.2d 236 (2d Cir. 1929) cited by Petitioner at Pet. 12, also applies the secondary test of

"plan and arrangement" of the works [31 F.2d at 238], just as the Ninth Circuit did at A-8. There is nothing different in the test for similarity. Likewise in petitioner's citations to *Flick-Reedy Corp.* v. *Hydro-Line Mfg. Co.*, 351 F.2d 546, 548 (7th Cir. 1965) and *Meredith Corp.* v. *Harper & Row Publishers, Inc.*, 378 F.Supp. 686, 690 (S.D.N.Y. 1974), aff'd per curiam, 500 F.2d 1221 (2d Cir. 1974), the respective courts found infringement based upon a usurpation of the structure, topical sequence and arrangement of the works at issue. The same is true in *Schroeder* v. *William Morrow & Co.*, 566 F.2d 3, 6 (7th Cir. 1977), where infringement was found in "selection, ordering and arrangement" of factual matter.

Finally,[1] in *Wainwright Securities, Inc.* v. *Wall Street Transcript Corp.*, 558 F.2d 91, 96 (2d Cir. 1977), the court specifically found that the defendant "appropriated almost verbatim the most creative and original aspects of" the accusing text. The court made a verbatim comparison in determining "substantial similarity" as was done by the Ninth Circuit herein. Is the petitioner asserting the Second Circuit has thereby established a "verbatim rule"? The answer is in the negative. The Second Circuit simply used verbatim comparison as one means to ascertain substantial similarity.

The Petitioner's cited law does not create a conflict among circuits. The analysis undertaken in the Second and Seventh Circuits is precisely the analysis undertaken by the Ninth Circuit in instant action. The Ninth Circuit reviewed

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[1]*Miller* v. *Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981) addressed a different question, *i.e.*, is research copyrightable.

the subject works for the best evidence of substantial similarity, *i.e.*, verbatim copying or close paraphrasing. Finding none, the court analyzed the works for structural and organizational content and concluded that respondent's work did not duplicate the selection, coordination and arrangement of ideas in the accusing work. Petitioner's disagreement with a holding of lack of copyright infringement is not a proper basis for the grant of certiorari.

V. CONCLUSION

The petition for issuance of a writ of certiorari should be denied.

Respectfully submitted,

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